UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 May 2007*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All   b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Applicant's Amendment filed on 5/11/2007. Claims 1-21 are pending in this

Office Action.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of

matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the

conditions and requirements of this title.

3.   Claim 12-14 are rejected under 35 U.S.C. 101, because none of the claims are

directed to statutory subject matter. The claims lack the necessary physical articles or

objects to constitute a machine or a manufacture within the meaning of 35 USC 101.

They are clearly not a series of steps or acts to be a process nor are they a combination

of chemical compounds to be a composition of matter. As such, they fail to fall within a

statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive

material" or "nonfunctional descriptive material." Both types of "descriptive material" are

nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d

at 1759. When functional descriptive material is recorded on some computer-readable

medium, it becomes structurally and functionally interrelated to the medium and will be

statutory in most cases since use of technology permits the function of the descriptive

material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d

1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on

a computer-readable medium, in a computer, or on an electromagnetic carrier signal,

does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that

the claims for an algorithm in *Benson* were unpatentable as abstract ideas because

"[t]he sole practical application of the algorithm was in connection with the programming

of a general purpose computer.").

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.
>
>   This application currently names joint inventors. In considering patentability of the claims
> under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was
> commonly owned at the time any inventions covered therein were made absent any evidence to the
> contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and
> invention dates of each claim that was not commonly owned at the time a later invention was made in

order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e),

(f) or (g) prior art under 35 U.S.C. 103(a).

5.   Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nakagawa et al. (USPA Pub. 2003/0159065) hereinafter Nakagawa, and in view of

("Strategy for Collecting Software Inventory Information Across a Local Area Network",

IBM Technical Disclosure Bulletin, 12/1994) herein after IBM Disclosure, and in view of

Schwarz, Jr. (US Patent 6,476,927).

6.   As per independent claim 1, Nakagawa teaches an apparatus for inspecting the

copyright of digital data on a network having a data providing device for providing digital

data on the network, and a copyright inspection device for taking out copy right

information from digital data provided by data device and inspecting the copyright of the

digital data based on the taken out copyright information page 1, paragraph [0010].

Nakagawa does not explicitly teach a system manager. However, Schwarz teaches the

claimed step of "a system manager, the system being manager being adapted" as a

central print server 14 (Fig. 9, col. 6, lines 42-46). Thus, it would have been obvious to

one of ordinary skill in the art at the time of the invention, to have combined the

teachings of the cited references because Schwarz's teachings would have allowed

Nakagawa's method to minimize network loads, while providing central printer control.

(col. 3, lines 58-60). Schwarz teaches the claimed step of "collecting attribute data from

multiple platforms" as from the polling information, the printer server decides 78 if there

is at least one compatible device 20 online (Fig. 7, col. 6, lines 1-3).

Nakagawa teaches the claimed step of "copyright data pertaining to software" as the attributes of the digital data are recorded at least a file size for URLs (page 4, paragraph [0050], paragraph [0062]). Further, Nakagawa teaches the claimed step of "recognize the copyright data in the attribute data" as the step 12, reads from the attribute recording file 26, the last update (page 5, paragraph [0063]). Further, Nakagawa teaches the claimed step of "process the copyright data into a list of copyright data for the system" as taking out the information may involve selecting a method for taking out copy right information form the extension etc. of the filename of the digital data being the object of inspection (page 5, paragraph [0068]. Further, Schwarz teaches the claimed step of "a user interface connected to the system manager for displaying the collected attribute data in the list to a user" as user interface for distribution of information to a receiver on a network (col. 3, lines 19-21). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because Schwarz's teachings would have allowed Nakagawa's method to minimize network loads, while providing central printer control. (col. 3, lines 58-60).

7.   As per dependent claim 2, Schwarz teaches the claimed step of "a user interface connected to the system manager for displaying attribute data in the list to a user" as user interface for distribution of information to a receiver on a network (col. 3, lines 19-21). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because

Schwarz's teachings would have allowed Nakagawa's method to minimize network

loads, while providing central printer control. (col. 3, lines 58-60).

8.   As per independent claim 3, Nakagawa teaches an apparatus for inspecting the

copyright of digital data on a network having a data providing device for providing digital

data on the network, and a copyright inspection device for taking out copy right

information from digital data provided by data device and inspecting the copyright of the

digital data based on the taken out copyright information page 1, paragraph [0010].

Nakagawa does not teach polling at least platforms. However, Schwarz teaches the

claimed step of "polling at least two platforms for attribute data" as the printer server 14

polls 76 the available printer devices 20 for their availability and current work load

(Fig. 7, col. 5, line 67 to col. 6, line 1). Schwarz teaches the claimed step of "collecting

the attribute data from the at least two platforms in response to the step of polling" as

from the polling information, the printer server decides 78 if there is at least one

compatible device 20 online (Fig. 7, col. 6, lines 1-3). Thus, it would have been obvious

to one of ordinary skill in the art at the time of the invention, to have combined the

teachings of the cited references because Schwarz's teachings would have allowed

Nakagawa's method to minimize network loads, while providing central printer control.

(col. 3, lines 58-60). Further, Nakagawa teaches the claimed step of "displaying the

collected attribute data on a user display" as the browser 22 provides an operating

environment for a user carrying out the operation of the HTML document (Fig. 3,

page 4, paragraph [0050]).

9.   As per dependent claim 4, Nakagawa and Schwarz combined teaches

independent claim 3. Schwarz teaches the claimed step of "collecting the attribute data

from the at least two platforms in response to the step of polling" as from the polling

information, the printer server decides 78 if there is at least one compatible device 20

online (Fig. 7, col. 6, lines 1-3). Thus, it would have been obvious to one of ordinary

skill in the art at the time of the invention, to have combined the teachings of the cited

references because Schwarz's teachings would have allowed Nakagawa's method to

minimize network loads, while providing central printer control. (col. 3, lines 58-60).

10.   As per dependent claim 5, Nakagawa teaches the claimed step of "step of polling

at least two platforms for attribute data further comprises the step of polling at least one

of the at least two platforms when polling is initiated by a user request" as the copyright

of digital data provided by the data providing device is inspected and the information is

taken from the device (Page 1, paragraph [0011] and paragraph [0049]).

11.   As per dependent claim 6, Nakagawa teaches the claimed step of "the step of

collecting the copyright information from the at least two platforms" as the attributes of

the digital data are recorded at least a file size for URLs (page 4, paragraph [0050],

paragraph [0062]).

12.   A method as in claim 7, Nakagawa and Schwarz combined teaches independent

claim 3. Nakagawa does not explicitly teach license information. However, Schwarz

teaches the claimed step of "the step of collecting the attribute data from the at least two

platforms in response to the step of polling further comprises the step of collecting the

license information from the at least two platforms" as user interface for the distribution

of information to a receiver on a network (col. 3, lines 20-23). Thus, it would have been

obvious to one of ordinary skill in the art at the time of the invention, to have combined

the teachings of the cited references because Schwarz's teachings would have allowed

Nakagawa's method to minimize network loads, while providing central printer control.

(col. 3, lines 58-60).

13.   As per dependent claim 8, Nakagawa teaches the claimed step of "the step of

storing the attribute data in non-volatile memory" as in the database 12 is stored

documents described by HTML (page 4, paragraph [0047]).

14.   As per dependent claim 9, Nakagawa teaches the claimed step of "the step of

displaying the collected attribute data on a user display further comprises the step of

automatically displaying the attribute data collected from the at least two platforms" as

carries out automatic copyright inspection with respect to plurality of HTML documents

(page 4, paragraph [0050]).

15.   As per dependent claim 10, Nakagawa teaches the claimed step of "the step of

displaying the collected attribute data on a user display further comprises the step of

manually displaying the attribute data collected from the at least two platforms" (page 1,

paragraph [0007] and paragraph [0049]).

16.   As per dependent claim 11, Nakagawa teaches the claimed step of "the step of

displaying the collected attribute data on a user display further comprises the step of

displaying only non-copyright attribute data collected from the at least two platforms" as

the step 12, reads from the attribute recording file 26, the last update (page 5,

paragraph [0065 & 67]).

17.   As per independent claim 12, Nakagawa teaches an apparatus for inspecting the

copyright of digital data on a network having a data providing device for providing digital

data on the network, and a copyright inspection device for taking out copy right

information from digital data provided by data device and inspecting the copyright of the

digital data based on the taken out copyright information (page 1, paragraph [0010]).

Schwarz teaches the claimed step of "a system controller for collecting the data form

multiple platforms" as the central printer server 14 for the polling information and the

printer server decides 78 if there is at least one compatible device 20 online (Fig. 7,

col. 6, lines 1-3). Thus, it would have been obvious to one of ordinary skill in the art at

the time of the invention, to have combined the teachings of the cited references

because Schwarz's teachings would have allowed Nakagawa's method to minimize

network loads, while providing central printer control. (col. 3, lines 58-60).

      Further, Nakagawa teaches the claimed "collecting the software copyright data"

as the attributes of the digital data are recorded at least a file size for URLs (page 4,

paragraph [0050], paragraph [0062]). Further, Nakagawa teaches the claimed "a user

interface connected to the system controller for displaying the software copyright data

from the memory to a user" as inspection of copyright may be executed once a week, at

12 o'clock each Saturday, then the load on the user carrying out inspection of copyright

can be reduced and also the inspection of copyright can be effectively carried out

(page 6, paragraph [0088]).

18.   As per dependent claim 13, Nakagawa teaches the claimed "the system

controller for collecting the software copyright data from multiple platforms further

comprises a memory for storing the software copyright data collected by the system

controller" as attribute recording file (page 5, paragraph [0063]).

19.   As per dependent claim 14, Nakagawa teaches the claimed "the memory for

storing the software copyright data collected by the system controller further comprises

non-volatile memory" as magnetic disk, magnetic drum, etc (page 6, paragraph [0089]).

20.   As per dependent claim 15, Nakagawa teaches the claimed "the system

manager collects attribute data from multiple platforms simultaneously" (page 6,

paragraph [0088]).

21.   As per dependent claim 16, Nakagawa teaches the claimed "the attribute data

collected is attribute data stored on the multiple platforms and is passed to the user

interface" (page 4, paragraph [0050]).

22.   As per dependent claim 17, Nakagawa teaches the claimed "the list is a list of

copyright years for the system in its entirety" as the attributes of the digital data the last

update date (Fig. 5, page 4, paragraph [0050]).

23.   As per dependent claim 18, Nakagawa teaches the claimed "the attribute data

comprises copyright and license data related to software" as the copyright inspection

software 24, at the time of inspecting whether or not the digital data for which one holds

the copyright is being used improperly (page 4, paragraph [0050]).

24.   As per dependent claim 19, Nakagawa teaches the claimed "the attribute data is

a list of copyright years related to each software object of the system" as the attributes

of the digital data the last update date (Fig. 5, page 4, paragraph [0050]).

25.   As per dependent claim 20, Nakagawa teaches the claimed "the multiple

platforms comprise document processing apparatus" as the WWW server 10 and the

client 20 are computers incorporating at least a central processing unit (CPU) and a

memory, which execute programs in the memory (Fig. 1, page 4, paragraph [0046]).

26.   As per dependent claim 21, Nakagawa teaches the claimed "the attribute data

comprising copyright data fop each software object on each platform" as the copyright

inspection software 24, at the time of inspecting whether or not the digital data for which

one holds the copyright is being used improperly (page 4, paragraph [0050]).

Response to Arguments

27.   Applicant's arguments filed on 5/11/2006 have been fully considered but they are

persuasive and the details as follows:

a)   Applicant's argument stated as "it is respectfully submitted that claims 12-

14 are directed to statutory subject matter and do not fall into any of the

exclusions encompassed by 35 U.S.C. 101."

In response to Applicant's argument, Examiner respectfully disagrees,

because, there is no physical device like a processor and a storage is not

incorporated in claims 12-14. These claims are Descriptive material and can be

characterized as either "functional descriptive material" or "nonfunctional

descriptive material." Therefore these claims deal with non-statutory subject

matter.

b)   Applicant's argument stated as "Applicant respectfully notes that Schwarz

has improperly been combined with Nakagawa and the IBM disclosure."

In response to applicant's argument that Schwarz is nonanalogous art, it

has been held that a prior art reference must either be in the field of applicant's

endeavor or, if not, then be reasonably pertinent to the particular problem with

which the applicant was concerned, in order to be relied upon as a basis for

rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24

USPQ2d 1443 (Fed. Cir. 1992). In this case, Schwarz teaches using a central

server connected to several clients and every client will have their processor and

software to print (see Fig. 9, col. 6, lines 42-46). Therefore Schwarz is

analogous the claims.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sathyanarayan Pannala whose telephone number is

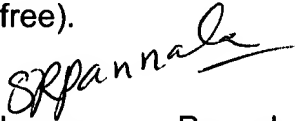(571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sathyanarayan Pannala
Primary Examiner

srp
July 20, 2007